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TOWNSEND and TOWNSEND and CREW LLP

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PATENT
Attorney Docket No. 021737-000110US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JEFFRY J. GRAINGER et al.

Application No.: 09/872,764

Filed: June 1, 2001

For: COMPUTER-IMPLEMENTED METHOD FOR SECURING INTELLECTUAL PROPERTY

Confirmation No. 2173

Examiner: Mary Da Zhi Wang Cheung

Technology Center/Art Unit: 3621

APPELLANTS' BRIEF UNDER 37 CFR §41.37

Via EFS Web
Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed October 28, 2008 and further to the Notice of Appeal mailed on January 11, 2007 for the above-referenced application, the Appellants submit this corrected Brief on Appeal (the "Brief"). Appropriate correction has been made to claims 1, 38, and 39 to place the claims in proper format as required by 37 CFR 41.37(c)(1)(viii). In addition, the "Related Appeals and Interferences" section has been updated with additional information made available since the filing of the original Brief on Appeal.

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST

FTF Technologies, Inc., of Boise Idaho, is the real party in interest. Corporation Service Company, of Wilmington, Delaware, has a majority ownership interest in FTF Technologies, Inc.

2. RELATED APPEALS AND INTERFERENCES

The following appeals may be related to, directly affect, be directly be affected by, or have a bearing on the Board decision in this appeal:

- U.S. Patent Application No. 09/733,616 (no appeal number assigned)
- U.S. Patent Application No. 09/919,764 (Appeal No. 2008-5054)
- U.S. Patent Application No. 09/919,768 (Appeal No. 2008-5163)
- U.S. Patent Application No. 09/996,338 (Appeal No. 2007-0776)
- U.S. Patent Application No. 09/996,341 (Appeal No. 2008-1228)
- U.S. Patent Application No. 09/997,311 (no appeal number assigned)

3. STATUS OF CLAIMS

Claims 1-17, 38 and 39 are currently pending in this application. Claims 18-37 have been canceled. All pending claims stand finally rejected pursuant to a Final Office Action mailed August 18, 2006. A copy of the claims as rejected is provided in the **Claims Appendix**, infra**.** Claims 1, 38 and 39 are independent claims.

Claims 1-3, 38 and 39 stand rejected under 35 U.S.C. § 102(a) as being anticipated by ePAVE User Guide, published by U.S. Patent and Trademark Office on January 12, 2000 (hereinafter, "ePAVE" or the "ePAVE reference"). Claims 4-8 and 11 stand rejected under § 103(a) as being unpatentable over ePAVE, claims 9 and 10 stand rejected under § 103(a) as being unpatentable over ePAVE in view of USP 5,982,989 (hereinafter, "Hsu"), claims 12-14 stand rejected under § 103(a) as being unpatentable over ePAVE in view of USP 6,182,078 (hereinafter, "Whitmyer"), and claims 15-17 stand rejected under § 103(a) as being unpatentable over ePAVE, in view of U.S. Patent Application Specification Authoring Guide for WordPerfect

XML template, published by U.S. Patent and Trademark Office on December 14, 1999 (hereinafter, "XML Guide").

The rejections of each of claims 1-17, 38 and 39 are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

An Amendment filed September 27, 2007 amended claims 1, 38 and 39 to place the claims in better form for appeal. As of the filing date of this Brief, the Examiner has not yet admitted the amendments. The amendments made by the September 27, 2007 Amendment are reflected in the **Claims Appendix**, infra

5. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates generally to computer programs for generating patent applications, as well as methods and systems that implement such computer programs. Merely by way of example, claim 1 is directed to a computer-implemented method for securing intellectual property rights. (Application, p. 2, ll. 8-9; p. 5, ll. 21-29). The method of claim 1 comprises providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out. (Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields))

The method of claim 1 further comprises actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form. (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)) In accordance with the method of claim 1, the server receives a filled-out invention disclosure in electronic form. (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2) The invention disclosure is then automatically converted into a format of a patent application. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 43, ll. 7-31; p. 44, l. 25-28) This conversion is performed in response to the server

computer's reception of a single click instruction input by the user on the client. (Application, p. 17, ll.13-23)

Claim 38 is directed to computer program embodied on one or more computer readable medium. (Application, p. 8, ll. 23-25; p. 9, ll. 1-7, p. 10, ll. 9-20) The computer program comprises instructions executable by one or more computers. (Application, p. 3, ll. 9-10; p. 9, ll. 1-7, p. 10, ll. 9-20) In accordance with claim 38, the instructions are executable by the computer(s) to provide, from a first server computer to a client computer, an electronic invention disclosure form to be filled out. (Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)) The instructions are further executable to actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), and to receive a filled-out invention disclosure in electronic form on the first server. (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2) The instructions are also executable by the computer(s) to automatically convert the invention disclosure form into a format of a patent application, in response to a single click instruction input by the user on the first client and received by the server. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 17, ll.13-23; p. 43, ll. 7-31; p. 44, l. 25-28)

Claim 39 is directed to a computer server for securing intellectual property rights. (Application, p.2, ll. 8-9; p. 5, ll. 21-29) The computer server of claim 39 comprises a processor and a computer readable medium, which comprises instructions executable by the processor. (Application, p. 2, ll. 8-9; p. 3, ll. 9-10; p. 8, ll. 23-28; p. 9, ll. 1-7, p. 10, ll. 1-20). The instructions are executable by the processor to provide to a client computer an electronic invention disclosure form to be filled out Application, p.1, ll. 11-12; p. 15, ll. 17-20; p. 34, l. 31-33; p. 35, ll. 1-3; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), to actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields

of the electronic invention disclosure form (Application, p.1, ll. 15-17; p. 15, ll. 17-20; p. 16, ll. 1-10; p. 41, ll. 15-16; *see generally* Application, Figs. 8C-8K (illustrating screen shots of various electronic invention disclosure forms having pre-selected fields)), to receive from the client computer a filled-out invention disclosure in electronic form (Application, p. 16, ll. 11-16; p. 32, l. 10; p. 41, l. 17; p. 44, ll. 1-2), and to automatically convert the invention disclosure form into a format of a patent application in response to a single click instruction input received from the user on the client computer. (Application, p.1, ll. 18-21; p. 16, ll. 17-27; p. 17, ll.13-23; p. 43, ll. 7-31; p. 44, l. 25-28)

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3, 38 and 39 are anticipated under 35 U.S.C. § 102(a) over ePAVE

2. Whether claims 4-8 and 11 are unpatentable under 35 U.S.C. § 103(a) over ePAVE.

3. Whether claims 9 and 10 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of Hsu.

4. Whether claims 12-14 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of Whitmyer.

5. Whether claims 15-17 are unpatentable under 35 U.S.C. § 103(a) over ePAVE, in view of XML Guide.

7. ARGUMENT

1. The rejections of claims 1-3, 38, and 39 under 35 U.S.C. § 102(a) should be reversed.

To support a rejection under 35 U.S.C. § 102, the Examiner is obligated to establish that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (quoting *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (quotation marks omitted). Moreover, although ipsis verbis disclosure of the claim elements is not required to establish anticipation, "[t]he elements must be arranged as required by the claim." *Id.*

The Final Office Action rejected claims 1-3, 38 and 39 under § 102(a) as being anticipated by ePAVE, implicitly asserting that ePAVE teaches each element of the rejected claims. The Appellant respectfully submits that the Examiner is mistaken in that regard, and that ePAVE in fact fails to teach, or even to suggest, each element of any claim rejected under § 102. In particular, it is worth noting that the present claims and ePAVE, respectively, are directed to solutions to two very different problems.

The rejected claims are directed to solutions for obtaining with a client system, information from an inventor (or another) that can be used, at a server system, to generate a patent application automatically, in response to a single click instruction input.

In contrast, the ePAVE program itself (the subject of the ePAVE reference relied upon by the final Office Action) is a software tool provided by the USPTO for submitting patent applications that already have been prepared (presumably using a manual process), and the ePAVE reference correctly describes that program as a tool that merely puts a pre-existing patent application in a proper data format for electronic filing. *See, e.g.*, ePAVE, at 39 ("The Attachments Tab allows you to attach your authored utility patent specification XML to your submission." (emphasis added)). The ePAVE reference nowhere teaches, or even suggests, that the ePAVE software might be used to generate a patent application automatically from a filled-out invention disclosure form. Accordingly, ePAVE teaches few, if any, elements of even the independent claims rejected under § 102.

a) Claim 1

For example, the final Office Action fails to show that ePAVE discloses many of the elements of claim 1, including without limitation, " providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out, " "receiving a filled-out invention disclosure in electronic form on the first server," and "automatically converting the

invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server." Accordingly, the final Office Action fails to establish that ePAVE anticipates claim 1, and the rejection of claim 1 under § 102 should be reversed.

(1) ePAVE fails to teach or suggest "an electronic invention disclosure form to be filled out"

Consider, for example, claim 1, which recites, inter alia, "providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out." The Examiner fails to demonstrate that ePAVE teaches or suggests this element. The final Office Action cites pages 1, 9, 12 and 17-21 as disclosing this element, Final Office Action, at 4, and argues that "ePave teaches an electronic invention disclosure forms to be filled out, such as patentee information, and attorney or agent information." Final Office Action 2 (citing ePAVE at 19-21).

Even assuming ePAVE discloses the functionality described by the Examiner (an electronic form for providing biographical information associated with a patent application), the mere ability to receive, on an electronic form, biographical information about a patentee and/or attorney does not teach or suggest that the ePAVE software provides any facility for an inventor to use that form to disclose an invention, functionality that is inherently required by the term "invention disclosure form." Nowhere does ePAVE disclose any ability to provide an electronic form for a user to disclose an invention, rather than mere biographical information. Indeed, Appendix A of ePAVE provides a "[d]etailed [d]escription of [s]creens and fields." ePAVE at 51. None of the listed screens or fields even remotely indicates that an invention disclosure might be stored in any of the ePAVE forms. *See* ePAVE at 51-54.

Consequently, no reasonable interpretation of ePAVE allows for the construction of that reference as teaching "providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out." Since this feature is required by claim 1, ePAVE fails to anticipate claim 1, and for at least this reason, ePAVE fails to anticipate claim 1, and the rejection of claim 1 under § 102(a) should be reversed.

(2) ePAVE fails to teach or suggest the client-server relationship required by claim 1.

Claim 1 also recites that the electronic invention disclosure form is "provid[ed], from a first server computer to a client computer," as well as "receiving a filled-out invention disclosure in electronic form on the first server." Even assuming that ePAVE could be interpreted to teach an electronic invention disclosure form (which, as noted above, it cannot), ePAVE still would fail to teach or suggest that the form is provided from a server computer to a client computer and that a filled-out disclosure is received by the same server, as required by claim 1.

ePAVE fails, for several reasons, to teach this combination of elements. First, ePAVE provides no teaching or suggestion that an electronic invention disclosure form might be provided from a server computer to a client computer. In fact, ePAVE expressly teaches the opposite, that the ePAVE software is a locally installed on a user's computer as a local application, rather than a client-server application: "The ePAVE software is a client application, and the current version must be installed on a local machine." ePAVE, at 14. Hence, assuming the ePAVE software provides any type of electronic invention disclosure form, it is provided from the client itself, not from a server computer to a client computer.

In addressing the client-server relationship required by claim 1, the final Office Action states,

> Examiner believes that ePave software program can be downloaded from USPTO related website to the user computer so that the user can create electronic version of a patent application (page 12); thus the ePave software program is provided by/from a first server computer, which is the USPTO server system.
>
> . . . Examiner believes that ePave teaches electronically submitting a filled-out patent application by a user, and the USPTO's computer will then send acknowledgement receipt (see page 29 and 49), that correspond to the limitation 'receiving a filled-out invention disclosure form on a first server'.

Final Office Action, at 2-3. The Appellants respectfully submit that, even assuming the ePAVE program itself can be downloaded from a server computer at the USPTO, the solitary fact that the software can be downloaded and installed locally does not teach or suggest providing an electronic invention disclosure form from a server computer. Rather, it is the ePAVE software itself, once it has been installed on the user's computer, that provides the electronic invention

disclosure form, not any server at the USPTO. Hence the fact that the ePAVE software can be downloaded from a server is immaterial to the question of whether the ePAVE reference discloses the provision of an electronic disclosure form from a server computer to a client computer (as claim 1 requires), and the Appellants respectfully submit that the ePAVE reference contains no such disclosure.

Second, claim 1 requires that the same server computer both (1) provides the electronic invention disclosure form and (2) receives the filled-out invention disclosure (as indicated by the use of the term "first server computer" in both elements), and the ePAVE reference provides no such teaching or suggestion. Indeed, the Examiner has not even demonstrated any teaching in ePAVE that a server at the PTO receives any information from the ePAVE client (although this perhaps could be inferred from the cited portions of ePAVE),[1] let alone that the same server at the USPTO both (1) provides the ePAVE software and (2) receives any information relating to an invention disclosure. Hence, even assuming that (1) ePAVE could be construed as teaching the provision of an electronic disclosure form from a server computer to a client computer (which it cannot, as noted above) and (2) ePAVE could be construed as teaching the reception of a filled-out invention disclosure form at a server (which it cannot, as noted below), ePAVE still would not teach, as claim 1 requires, that the same server computer is involved in both of these operations. Moreover, any such inference would be unreasonable, since it is far more likely that the server for receiving ePAVE submissions is a specialized server, rather than a generic web server, which would have to be used to provide the ePAVE software for download.

Hence, the final Office Action fails to establish that ePAVE teaches or suggests the client-server relationship required by claim 1, and the rejection of claim 1 should be reversed for this additional reason.

[1] The final Office Action cites pages 29-31 and 49 of ePAVE as teaching "receiving a filled-out invention disclosure form on the first server." *See* Final Office Action at 3, 4. Those pages refer only to "transmitting your package to the USPTO," *e.g.*, ePAVE at 29, not to any server actually receiving the transmission.

(3) ePAVE fails to teach or suggest receiving a filled out invention disclosure in electronic form on a server and automatically converting the invention disclosure form into a format of a patent application.

Moreover, the final Office Action has not established that the ePAVE reference teaches the combination of "receiving a filled-out invention disclosure in electronic form on the first server" and "automatically converting the invention disclosure form into a format of a patent application," as required by claim 1. Instead, as noted above, the ePAVE reference specifically teaches that the ePAVE tool is designed to package a pre-prepared patent application for filing,[2] so it is difficult to see how the teachings of ePAVE could be read as either receiving a filled-out invention disclosure form or automatically converting such a form into a form of a patent application.

As noted above, the final Office Action takes the position that pages 29-31 and 49 of ePAVE teach the reception of a filled-out invention disclosure in electronic form on a server. These pages, however, fail to discuss anything more specific than "fil[ing] your submission directly with the USPTO over the Internet" (p. 29), "[t]ransmitting your [s]ubmission" and "transmit[ing] your file to the USPTO" (p. 21), and "[a]fter the package has been transmitted to the USPTO" (p. 49). None of these passages (nor anything else in the ePAVE reference) even remotely disclose that the "submission" or the "package" might be a "filled out invention disclosure in electronic form," as required by claim 1. Indeed, the whole purpose of ePAVE is for electronically filing a patent application or sequence listing, so it is reasonable only to assume that the terms "submission" and "package" mean either an application or a sequence listing, not a patent application.

Moreover, the disclosure in ePAVE of receiving a patent application cannot teach the recited reception of a filled-out invention disclosure form, because claim 1 further requires the automatic conversion of that disclosure form to a form of a patent application, which would

[2] *See also* ePAVE at 1 ("The development and public release of an electronic filing system for direct submission of . . . biotechnology listings and utility patent applications to USPTO moves the USPTO closer to attaining the goal of electronic filing of all patent applications by 2003. . . . The system will accept . . . XML-formatted utility patent specifications." (emphasis added))

not be possible if it were already a patent application. Hence, for at least this additional reason, ePAVE fails to anticipate claim 1, and the rejection of claim 1 should be reversed.

(4) ePAVE fails to disclose "automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server."

Finally, ePAVE fails to teach or suggest either the automatic conversion of an invention disclosure form into a format of a patent application or that such conversion (if it even existed) would be performed by the ePAVE software in response to a single click input on the client and received by the server.

First, ePAVE provides no disclosure that the ePAVE software might convert an invention disclosure form to a format of a patent application, automatically or otherwise. The final Office Action argues that "ePave further teaches by click on 'Send to USPTO' button, the user's input regarding to the patent application will be filed as an electronic patent application in USPTO," Final Office Action at 3, and cites pages 18-19 and 28-29 as teaching this element. Final Office Action at 4. Pages 18 and 19 of ePAVE discuss the filing of sequence listings subsequent to the filing of an application, so it is difficult to see how these listings, filed after the application has been both created and filed, possibly could be an invention disclosure form that is converted into a format of a patent application. Pages 28 and 29 discuss details about electronic filing with the USPTO, but have nothing to do with conversion of an electronic disclosure form into a format of a patent application. Hence, the final Office Action has failed utterly to identify any teaching in ePAVE that the software might be able to convert an electronic disclosure form into a format of a patent application.

Moreover, the final Office Action appears to rely on the "Send to USPTO" button illustrated on screen shots on pages 18-19 and 28-29 as teaching "in response to a single click instruction input by the user on the first client and received by the server." However, there are two problems with this line of argument. First, as noted above, there is no indication that this button actually converts an electronic invention disclosure form into a format of a patent application, and the button's label itself indicates that the only functionality prompted by the

button is the transmission of an application to the USPTO, not the conversion of any information disclosure form. Second, claim 1 requires that the "single click instruction" is "input by the user on the . . . client and received by the server." ePAVE does not disclose this requirement, and in fact, would seem to operate in the opposite fashion: the input from the button necessarily must be received by the client (not the server), because the input instructs the client to send the submission to the server (even assuming that ePAVE teaches a server at all)—the input provides no instruction to the server itself. Consequently, the final Office Action fails to establish that ePAVE teaches this element of claim 1 either.

The final Office Action falls fall short of demonstrating that ePAVE teaches all of the elements of claim 1. In fact, the final Office Action arguably fails to establish that ePAVE teaches any of the elements of claim 1. For this reason, the Board should reverse the rejection of claim 1 under § 102 as being anticipated by ePAVE

b) Claims 38-39

Claims 38 and 39 were rejected under § 102(a) as being anticipated by ePAVE. Those claims are directed to a computer program and a computer server, respectively, and they recite elements substantially similar to those discussed above with respect to claim 1. The Appellants respectfully submit, therefore, that claims 38 and 39 are allowable over ePAVE for at least the reasons discussed above, and that the rejections of claims 38 and 39 under § 102 should be reversed as well.

c) Claims 2 and 3

Claims 2 and 3 were also rejected under § 102(a) as being anticipated by ePAVE. Claims 2 and 3 each depend from claim 1 and therefore are believed to be allowable over ePAVE for at least the reasons described above. Moreover, each of those claims recites additional limitations that are neither taught nor suggested by ePAVE and are allowable for this additional reason as well.

Claim 2 recites "active prompting of an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention," while claim 3 recites "active prompting of an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention." ePAVE teaches neither of these features. The final Office Action cites pages 17-21 and 51-52 as teaching the limitations of both claim 2 and claim 3. The cited passages, however, are bereft of any such teaching—those passages all pertain to fields provided in the user interface of the ePAVE software, but none of those fields even remotely pertains to either a best mode known to the inventor or detailed information required to enable one of ordinary skill in the art to practice the invention. Hence, the final Office Action fails to establish that ePAVE teaches the limitations of claims 2 and 3, and even if the rejection of claim 1 is affirmed, the rejections of claims 2 and 3 should be reversed.

2. The rejections of claims 4-17 under 35 U.S.C. § 103(a) should be reversed.

The office action rejected claims 4-17 under § 103(a) as being unpatentable over ePAVE, taken either alone or in combination with Hsu, Whitmyer or XML Guide. To establish a prima facie case that a claim is unpatentable under § 103, a rejection must, inter alia, show that "all claim limitations [are] taught or suggested by the prior art." MPEP § 2143.03. As noted above, ePAVE fails to teach or suggest all (or perhaps even any) elements of claim 1, so the final Office Action has not even established a prima facie case that claim 1 is unpatentable under § 103. None of the other cited references provide the disclosure missing from ePAVE, so claim 1 would be allowable over any combination of ePAVE, Hsu, Whitmyer and XML Guide:

Hsu pertains to "[a]n improved secure communication arrangement [that] separates the tasks of identify verification and certificate issuing . . ." Hsu, Abs. Hsu is cited by the final Office Action only as teaching private/public key encryption, Final Office Action at 6, and has nothing to do with invention disclosures and applications specifically. Hsu, therefore, fails to disclose any of the limitations of claim 1 missing from ePAVE..

For its part, Whitmyer "relates to a system for delivering professional services over the Internet," Whitmyer, c. 1, ll. 12-13, and generally discloses software with docketing, calendaring, and client communication functions. *See* Whitmyer, c. 3, ll. 38-65. Whitmyer is

cited by the final Office Action only as teaching generating a reminder regarding important events. Final Office Action at 7. Whitmyer does not, however, provide any teaching or suggestion of any element of claim 1.

With respect to XML Guide, "[t]he purpose of [XML Guide] is to provide you with the information needed to author structured Specification documents." XML Guide at 3. This reference is cited by ePAVE as disclosing "submitting drawings along with the electronic patent application" (although this is not an element any of claims 15-17, against which XML Guide is cited). XML Guide does discuss a manual process (which is assisted by computer software) for formatting an existing patent application in XML, but this disclosure fails to teach even the automatic conversion feature recited by claim 1, since the process disclosed by XML Guide is not automatic, as indicated by the quotation above. XML Guide provides no disclosure of any other element recited by claim 1.

Accordingly, claim 1 would be patentable over any combination ePAVE, Hsu, Whitmyer and XML Guide.. Claims 4-17 all depend from claim 1, so the Appellant respectfully submits that claims 4-17 are allowable at least by virtue of that dependence.

3. The rejection of claim 5 under 35 U.S.C. § 103(a) should be reversed.

Moreover, the final Office Action fails, with respect to several of these dependent claims, to establish even that the cited reference teaches the additional elements of those dependent claims. For example, claim 5, which was rejected under § 103(a) as being unpatentable over ePAVE, recites "wherein information in pre-selected fields of the invention disclosure form is selectively placed in a pre-selected location in said patent application." The office action takes the position that pages 18-19 and 28-29 of ePAVE disclose this feature. While those pages do illustrate fields on the ePAVE user interface, there is no teaching or suggestion in ePAVE that information in those fields is placed in a patent application at all, let alone in a pre-selected location in a patent application." The rejection of claim 5, therefore, should be reversed for this additional reason.

4. The rejection of claims 15-17 under 35 U.S.C. § 103(a) should be reversed.

Claims 15-17 stand rejected under § 103(a) as being unpatentable over the combination of ePAVE and XML Guide. The final Office Action, however, fails to establish a prima facie case that any of these claims are obvious over the cited combination. For example, claim 15 recites "providing drawing tool icons to facilitate creation of figures to be included in the filled-out invention disclosure," and neither page 26 of XML Guide (cited by the final Office Action) nor anything else in that reference teaches or suggests this element.

Similarly, neither ePAVE nor XML Guide teaches or suggests either "active prompting of the inventor by the smart disclosure form to create figures depicting novel aspects of the invention," as recited by claim 16, or "receiving as input a single click on a scan button to cause a drawing to be scanned and included as a figure in the filled-out invention disclosure form," as recited by claim 17.

In fact, the final Office Action fails to address the specific elements of claims 15-17 entirely, providing only an omnibus statement that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to allow ePave to include the function of submitting drawings along with the patent application . . . " Final Office Action at 8. This falls far short of establishing a prima facie case that any of claims 15-17 are unpatentable under § 103. Accordingly, the rejections of claims 15-17 should be rejected for this additional reason.

8. CONCLUSION

For these reasons, it is respectfully submitted that all of the rejections in the final Office Action should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

1. (Previously Presented) A computer-implemented method for securing intellectual property rights, the method comprising:

providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out;

actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form;

receiving a filled-out invention disclosure in electronic form on the first server; and

automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server.

2. (Previously Presented) The method of claim 1 further comprising:

active prompting of an inventor by the disclosure form to provide best modes known to the inventor for practicing an invention.

3. (Previously Presented): The method of claim 2 further comprising:

active prompting of an inventor by the disclosure form to provide detailed information required to enable one of ordinary skill to practice the invention.

4. (Previously Presented): The method of claim 3 further comprising:

active prompting of an inventor by the disclosure form to identify co-inventors, if any, of the invention,

wherein the disclosure form prompts an inventor to input information in pre-selected fields.

5. (Previously Presented) The method of claim 4:

wherein information in pre-selected fields of the invention disclosure form is selectively placed in a pre-selected location in said patent application.

6. (Original) The method of claim 5 wherein the single click also causes the patent application to be filed at a patent office.

7. (Original) The method of claim 6 wherein the patent application is filed at the patent office electronically.

8. (Original) The method of claim 7 further comprising:

executing the patent application with a digital signature of an inventor, assignee, or registered patent practitioner before the patent application is filed.

9. (Previously Presented) The method of claim 7 further comprising:

encrypting the patent application with a private key of the inventor, assignee, or registered patent practitioner before the patent application is filed.

10. (Original) The method of claim 9 further comprising:

maintaining a registry of public keys at the patent office; and

decrypting the patent application with a public key for the inventor, assignee, or registered patent practitioner.

11. (Original) The method of claim 7 further comprising:

transmitting notification that the patent application was filed to an intellectual property (IP) server.

12. (Original) The method of claim 11 further comprising:

automatic calendaring by the IP server of a deadline date for foreign filing under an international convention.

13. (Original) The method of claim 12 further comprising:

transmitting a reminder communication from the IP server to a specified address at a specified time period before the deadline date.

14. (Original) The method of claim 12 wherein the patent application comprises a provisional patent application and further comprising:

automatic calendaring by the IP server of a deadline date for converting the provisional patent application to a non-provisional patent application.

15. (Original) The method of claim 4 further comprising:

providing drawing tool icons to facilitate creation of figures to be included in the filled-out invention disclosure.

16. (Original) The method of claim 15 further comprising:

active prompting of the inventor by the smart disclosure form to create figures depicting novel aspects of the invention.

17. (Original) The method of claim 4 further comprising:

receiving as input a single click on a scan button to cause a drawing to be scanned and included as a figure in the filled-out invention disclosure form.

18–37. (Canceled)

38. (Previously Presented) A computer program embodied on one or more computer readable medium, the computer program comprising instructions executable by one or more computers to:

provide, from a first server computer to a client computer, an electronic invention disclosure form to be filled out;

actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the-electronic invention disclosure form;

receive a filled-out invention disclosure in electronic form on the first server; and

automatically convert the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server.

39. (Previously Presented) A computer server for securing intellectual property rights, the computer server comprising a processor and a computer readable medium, the computer readable medium comprising instructions executable by the processor to:

provide to a client computer an electronic invention disclosure form to be filled out;

actively prompt a user of the client computer to provide information corresponding to an invention into pre-selected fields of the electronic invention disclosure form;

receive from the client computer a filled-out invention disclosure in electronic form; and

automatically convert the invention disclosure form into a format of a patent application in response to a single click instruction input received from the user on the client computer.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

Appeal No. 2007-0776, U.S. Patent Application No. 09/996,338

-- Decision on Appeal dated September 7, 2007

Appeal No. 2008-1228, U.S. Patent Application No. 09/996,341

-- Decision on Appeal dated August 8, 2008

Appeal No. 2007-0776, U.S. Patent Application No. 09/996,338
-- Decision on Appeal dated September 7, 2007

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JEFFRY J. GRAINGER

Appeal 2007-0776
Application 09/996,338
Technology Center 3600

Decided: September 27, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffry J. Grainger (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 4-9, 11-13, and 19-34, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is to a computer-implemented method of facilitating the preparation of intellectual property documents, such as patent applications, securing intellectual property rights and managing intellectual property assets (Specification 1:11-15). Claim 19, reproduced below, is representative of the subject matter on appeal.

> 19. A method of managing electronic documents related to a plurality of patent applications, the method comprising:
>
> for a plurality of different and unrelated technology developers, allowing users from each such technology developer to create a plurality of invention disclosures for each respective technology developer;
>
> receiving the plurality of invention disclosures from the users from each technology developer at a server system over a network and storing each invention disclosure in one of a plurality of collections of electronic documents and data in a computer-readable memory operatively coupled to the server system, wherein each collection is associated with one of the plurality of patent applications and assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection;

storing, in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents such that at least some users associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that users associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents for users associated with a plurality of patent firms such that at least some users from selected ones of the patent firms have rights to view selected invention disclosures stored in the collections and selected electronic documents stored in the collection selected invention disclosure is stored in and create and modify patent applications prepared for the selected invention disclosures;

receiving any such created patent application at the server system and storing it in the collection of electronic documents the respective invention disclosure is stored in;

maintaining and enforcing rights to file patent applications in a patent office for users associated with the plurality of law firms such that only selected users from the law firms have rights to file patent applications in the patent office; and

electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request;

wherein each user from the plurality of different and unrelated technology developers and each user from the plurality of patent law firms is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection; and

wherein when a user generates a request to perform an operation on an electronic document in a particular collection of electronic documents, in response to receiving the request, determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document assigned; (iii) one or more roles to which the user is assigned (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned,

> the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Takano	US 6,434,580 B1	Aug. 13, 2002
Serbinis	US 6,584,466 B1	Jun. 24, 2003

The Appellant seeks our review of the rejection of claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis. This issue turns on whether:

1) Takano and Serbinis, when considered collectively, teach or suggest all of the elements of the claimed invention;

2) The combined teachings of Takano and Serbinis would have led one having ordinary skill in the art to the claimed invention; and

3) The Appellant has shown that one having ordinary skill in the art at the time the invention was made would not have had a reasonable expectation of success in combining the teachings of Takano and Serbinis.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers connected to a communications network, such as the Internet (Takano, col. 1, ll. 13-18). In particular, Takano's system includes client computers 100 and 200 and a server computer 300, which are connected to one another via a communications network, such as the Internet (Takano, col. 5, ll. 46-51).
2. Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (Takano, col. 5, ll. 55-61).
3. Takano discloses that a person working in the company application processing department or an outside person at a law firm representing the company (collectively referred to hereafter as the patent attorney) uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (Takano, col. 6, ll. 5-13).
4. Takano describes that once the inventor has registered the draft data for the specification on the server computer 300, the patent attorney can

access the draft on client computer 200 in order to revise it (Takano, col. 8, ll. 7-11). Takano describes that the system may restrict the patent attorney's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (Takano, col. 8, ll. 14-18).

5. Similarly, Takano describes that after the patent attorney finishes revising the draft, the inventor can then review the revisions (Takano, col. 10, ll. 8-15). Takano again describes that the system may restrict the inventor's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (Takano, col. 10, ll. 15-22).

6. As such, Takano imposes access controls on the information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information. The identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney).

7. Takano also discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component (Fig. 18) (element 205 (patent application document data transmitting means)) to file the application in the patent office.

8. In particular, Takano describes a sixth embodiment of the system (Takano, col. 16, l. 15 – col. 18, l. 18), which includes a client computer 500 to be used by the Patent Office to receive patent application filings transmitted from the patent attorney via client computer 200 (Takano, col. 16, ll. 45-50). As we found *supra*, Takano teaches that the DMS system can be configured so that the patent attorney may be allowed to access only those patent applications that pertain to a certain group, such as inventors belonging to a specific department (FF 4). As such, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such documents.

9. Takano further discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (Takano, col. 9, ll. 11-22).

10. Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by the field headings to complete the input fields via an invention report information screen (Takano, col. 7, ll. 11-26; Fig. 3).

11. Serbinis discloses an apparatus and methods for managing electronic documents over open networks, such as the Internet, to permit users to store, retrieve, and collaboratively manipulate files (Serbinis, col. 1, ll. 6-9). Serbinis discloses that the apparatus and method includes an Internet-based document management system (DMS) wherein an electronic

document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (Serbinis, col. 3, ll. 15-20).

12. The server is programmed to provide a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service (Serbinis, col. 4, ll. 18-23).

13. Serbinis describes that the server is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (Serbinis, col. 3, ll. 32-34).

14. Serbinis discloses that each user of the DMS system has access to one or more document groups, where each document group comprises a collection of document objects (Serbinis, col. 7, ll. 18-21). Each document stored in the DMS system also has an associated state, e.g., pending, active, archived, canceled, and deleted (Serbinis, col. 7, l. 63 – col. 8, l. 1). Serbinis discloses that certain users have access to particular document based on the state associated with the document. For example, document instances marked "active" are accessible by all Authorized Users, but document instances marked "archived" are accessible only to the document Originator (Serbinis, col. 8, ll. 10-17). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in

the role of the Originator, the user can access an archived document and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document.

15. Serbinis further describes that a document Originator, in using the DMS system, uploads and stores a previously-created document in the system and then defines one or more Authorized Users who may access the document (Serbinis, col. 8, l. 64 – col. 9, l. 3 and col. 9, ll. 19-22). The Originator also specifies the types of access that each Authorized User is to receive, e.g., retrieve, review, or modify (Serbinis, col. 9, ll. 22-28). In this example, if the Originator designates only one Authorized User, then that user's role is as the sole Authorized User, and the system imposes the use permissions (e.g., retrieve, review, or modify) for that document based on the type of access previously-defined by the Originator for the user role.

16. Serbinis further discloses that users are granted rights via the DMS authorization system, which defines the rights users have on particular document objects, document instances, and document groups (Serbinis, col. 12, ll. 24-27). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (Serbinis, col. 12, ll. 38-42). As such, Serbinis discloses another example of imposing use permissions based on the user's role

(e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document.

17. As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document.

18. Serbinis further discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (see Fig. 2, block 61).

19. Serbinis also discloses that the DMS system database includes user information tables 62 that include user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group (Serbinis, col. 6, ll. 41-46 and Fig. 2, block 62).

20. As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator's list of Authorized Users for this document? (FF 15) Or is the user part of a group, and if so, what document rights are associated with that group? (FF 19)), (ii) a second group to which the electronic document is assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is

assigned (i.e., is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to the document in the role as an Originator? (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF18)).

21. Serbinis further suggests that information from its DMS system can be presented to the user on a web page via a web browser without the need for a specialized client application (Serbinis, col. 2, ll. 3-20).

22. Serbinis defines a "closed system" as "a closed client/server architecture network, such as a local area network or wide area network" and provides an example of an "open system" as one that makes electronic documents available via the Internet (Serbinis, col. 1, ll. 12-15 and col. 2, ll. 12-13).

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The Supreme Court stated that there are "[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine." *Id.* at 1739, 82 USPQ2d at 1395. "In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at 1739-40, 82 USPQ2d at 1395. "*Sakraida and Anderson's-Black Rock* are illustrative – a court must ask whether the improvement is more that the predictable use of prior art elements according to their established function." *Id.* at 1740, 82 USPQ2d at 1395.

The Supreme Court stated that "[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." *Id.* The Court explained

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41, 82 USPQ2d at 1396. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

ANALYSIS

The Appellant summarizes his arguments as follows:

> Takano and Serbinis each fail (either individually or collectively) to teach or suggest each element of any pending claim. Further, the Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner. Finally, there would be no reasonable expectation of success in the proposed combination of Takano and Serbinis.

(Appeal Br. 8).[1] We address each of these arguments in turn.

[1] Only those arguments actually made by the Appellant have been considered in this decision. Arguments which the Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2006).

First Contention: Takano and Serbinis fail to teach or suggest each element of any pending claim.

The Appellant elaborates on his first contention by pointing to specific claim language in independent claims 19, 20, and 27, and in dependent claim 8, that he contends are neither taught nor suggested by Takano and Serbinis. In particular, the Appellant contends that the subject matter of claims 19, 20, and 27 is not obvious because "[n]either Takano nor Serbinis teach[es] the use permissions in user roles to determine whether a user can perform an operation on an electronic document" (Appeal Br. 10-12). We disagree.

Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers 100, 200, and 300 connected to a communications network, such as the Internet (FF 1). Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (FF 2), and that a patent attorney uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (FF 3). Takano describes that the system may restrict the patent attorney's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (FF 4). Similarly, Takano describes that the system may restrict the inventor's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (FF 5). As such, Takano imposes access controls on the

information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information (FF 6). In this case, the identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney) (FF 6).

Serbinis discloses further access controls within the context of a document management system. Serbinis discloses an apparatus and method for managing electronic documents using an Internet-based document management system (DMS) wherein an electronic document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (FF 11) The server is programmed to provide a plurality of document management services and is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (FF 12, 13).

Serbinis discloses that each user of the DMS system has access to one or more document groups and each document stored in the DMS system also has an associated state, such that certain users have access to particular documents based on the state associated with the document (FF 14). For example, document instances marked "active" are accessible by all Authorized Users, but document instances marked "archived" are accessible only to the document Originator (FF 14). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in the role of the Originator, the user can access an archived document

and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document (FF 14).

Serbinis further describes that a document Originator defines one or more Authorized Users who may access the document and also specifies the types of access that each Authorized User is to receive, so that if the Originator designates only one Authorized User and that user's role is as the sole Authorized User, then the system imposes the use permissions based on the type of access previously-defined by the Originator for the Authorized User role (FF 15).

Serbinis further discloses that users are granted rights based on particular document objects, document instances, and document groups (FF 16). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (FF 16). As such, Serbinis discloses another example of imposing use permissions based on the user's role (e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document (FF 16).

As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document (FF 17). Accordingly, we find the Appellant's argument that neither Takano nor Serbinis discloses use permissions in user roles to be without merit.

The Appellant further contends that "[n]either Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, and (iii) permissions associated with user roles to determine whether a user can perform an operation on an electronic document, as recited by claim 27" (Appeal Br. 13). The Appellant similarly contends that "Serbinis and Takano each fail (either individually or collectively) to teach or suggest using this combination, along with (iv) unit-level access information, to make such a determination, as recited by claims 19 and 20" (*Id.*). We disagree.

Serbinis, for example, discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (FF 18). Serbinis also discloses that the DMS database includes user information tables that include user group information, i.e., information on the group of users that the user is a part of, including the group's security information, and document rights for the group (FF 19). Further, as found *supra*, the DMS system of Serbinis maintains a list of Authorized Users designated by an Originator (FF 15), information on the state of each document which dictates which users have access to the document (FF 14), and information about the role of a user as Originator or Authorized User (FF 16).

As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator's list of Authorized Users for this document? (FF 15) Or, is the user part of a group, and if so, what document rights are associated with that group (FF 19)), (ii) a second group to which the electronic document is

assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is assigned (Is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to this document in the role as an Originator (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF 18)). (FF 20.) Accordingly, we find the Appellant's argument that neither Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, (iii) permissions associated with user roles, and (iv) unit-level access information to determine whether a user can perform an operation on an electronic document to be without merit.

The Appellant further contends that the subject matter of claims 19 and 20 is not obvious because Serbinis and Takano do not teach or suggest "determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request" (claim 19) or "a patent application filing component" (claim 20) (Appeal Br. 14-15). We find the Appellant's arguments unpersuasive.

Takano discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component to file the application in the patent office (FF 7). In particular, as described in Takano, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such

documents, and thus the system allows only those patent attorneys with the appropriate rights to file patent applications at the patent office (FF 8).

The Appellant further contends that the subject matter of dependent claim 8 is not obvious because neither of the cited references teaches or suggests that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page (Appeal Br. 15).

Takano discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (FF 9). Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by field headings to complete the input fields via an invention report information screen (FF 10). The Appellant contends that "[p]roviding a template for a specification form is in no way similar to presenting questions to be answered by an inventor." We fail to see a patentable difference between the prompts or input fields described in Takano and a list of questions posed to the user. In either case, whether the prompts are in the form of phrases, statements, or questions, the words prompt the user to enter information. Although Takano discloses that communications between the inventor and the server occur via the Internet, Takano does not explicitly state that it uses web pages for this communication.

Serbinis, however, clearly teaches that information from its document management system can be presented to the user on a web page via a web browser without the need for a specialized client application (FF 21). We find that it would

have been obvious to one having ordinary skill in the art at the time the invention was made to have presented Takano's patent specification templates and invention report information screens to users via a web page because both Takano and Serbinis disclose access via the Internet and Serbinis suggests using web pages to display information to the user to eliminate the need for a specialized client application. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 ("if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.") As such, we find the Appellant's argument that neither Takano nor Serbinis discloses that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a web page to be unpersuasive.

Second Contention: The Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner.

The Appellant elaborates on his second contention by arguing that because Takano is directed to a closed system and thus does not contemplate a system with multiple, independent entities, Takano does not have any need for the access control protocols of Serbinis (Appeal Br. 17). The Appellant further argues that the Examiner failed to identify how the teachings of Serbinis might provide additional benefit in the areas of collaborative file sharing and workflow,

document delivery, and document distribution over what Takano already provides (*Id.*).

As we found *supra*, Takano discloses that its DMS system is designed to be used via the Internet (FF 1). As such, we find no basis for the Appellant's contention that Takano is directed to a closed system. Serbinis defines a "closed system" as "a closed client/server architecture network, such as a local area network or wide area network" and provides an example of an "open system" as one that makes electronic documents available via the Internet (FF 22). As such, both Takano and Serbinis envision document management systems that use open systems (e.g., accessible via the Internet) to make documents available to users. Further, we disagree with the Appellant's contention that Takano does not have any need for access control protocols. On the contrary, as we found *supra*, Takano implements access controls to restrict inventor and patent attorney access to information on the server computer 300 (FF 4, 5).

Further, the Appellant's argument that the Examiner fails to identify how the teachings of Serbinis might provide additional benefit to Takano misses the mark. As demonstrated by our findings of fact, Serbinis clearly discloses improvements to the access control restrictions in a document management system. These improvements add additional layers of security to the documents. Takano deals with the highly confidential, proprietary, and privileged communications between attorneys and clients regarding inventions and patent applications. It would have been obvious to one having ordinary skill in the art to have implemented the improved access control restrictions, as taught by Serbinis, in the system of

Takano, to better protect access to highly sensitive patent application information and to better ensure control over the disclosure of the information contained therein. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 ("if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.")

Third Contention: There would be no reasonable expectation of success in the proposed combination of Takano and Serbinis

The Appellant elaborates on his third contention by arguing that because the system of Takano uses specialized software on the client and server, if a user attempted to connect to the DMS of Serbinis with the client software of Takano, there would be no reasonable expectation that such a connection would be successful (Appeal Br. 19). In particular, the Appellant asserts that "nothing in Takano teaches or suggests that the client software of Takano might be configured to interoperate generally with a web server using HTTP and servlets" (*Id.*). The Appellant's argument seems to amount to a contention that because the system of Takano would require modification, there would have been no reasonable expectation of success. This is not the test for reasonable expectation of success and the law on motivation to combine does not require an explicit teaching or suggestion in the reference for the modification. *See KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396 ("the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the

inferences and creative steps that a person of ordinary skill in the art would employ.") Additionally, the Appellant has not demonstrated unpredictability of this field of art at the time of the invention or even that the modifications to Takano would have beyond the skill level of one of ordinary skill in the art at the time of the invention. As noted by the Examiner (Answer 48), the Appellant has provided no evidence to support his assertion that a person having ordinary skill in the art would have had no reasonable expectation of success in the combination of Takano and Serbinis. Without more, we find the Appellant's argument unpersuasive. As such, we find that a prima facie case of obviousness of the claimed invention exists in view of the combined teachings of Takano and Serbinis, and the Appellant's arguments have failed to persuade otherwise.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

DECISION

The decision of the Examiner to reject claims 4-9, 11-13, and 19-34 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

jlb

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Appeal No. 2008-1228, U.S. Patent Application No. 09/996,341
-- Decision on Appeal dated August 8, 2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CECILY ANNE SNYDER

Appeal 2008-1228
Application 09/996,341
Technology Center 3600

Decided: August 8, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Cecily Anne Snyder (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-3 and 5-26. Claim 4 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM. [1]

THE INVENTION

The Appellant's invention relates to a method for managing legal cases and particularly patent applications. Specification [09] and [18]. In particular, the invention pertains to a docketing method for cases whereby a message is generated upon receipt of a signal indicative of an occurrence of an event, such as a deadline in the case, and communicated to a client, e.g., a client computer. See Specification [19] and Fig. 1. The method comprises storing data and documents related to the case and, upon receiving the signal and identifying a rule associated with the event and a first rule related to the case, generating a message using the first rule, "the message identifying an action to be performed in response to the event and identifying a date associated with the action" (Specification [19]).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A computer-implemented method of generating a message for a first intellectual property case, the method comprising:
>
> storing information related to a plurality of intellectual property cases on a computer-readable

---

[1] Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed Dec. 26, 2006) and the Examiner's Answer ("Answer," mailed Mar. 9, 2007).

medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case;

receiving a signal indicating occurrence of an event related to the first intellectual property case;

responsive to receiving the signal, identifying one or more rules associated with the event;

identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium;

generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

communicating the at least one message to a first designated client system.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kamarei	US 6,859,806 B1	Feb. 22, 2005
Lee	US 7,016,852 B1	Mar. 21, 2006

The following rejections are before us for review:

1. Claims 1, 2, and 5-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kamarei.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kamarei.
3. Claims 21-26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee.

ISSUES

The issues before us are whether the Appellant has shown that the Examiner erred in rejecting claims 1, 2, and 5-20 as anticipated by Kamarei; claim 3 as unpatentable over Kamarei; and, claims 21-26 as unpatentable over Kamarei and Lee. These issues turn on whether Kamarei describes the step in claim 1 of:

> storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. The storing step of claim 1 reads: "storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case."
2. The storing step of claim 1 describes storing information. The information is characterized as being related to intellectual property cases.
3. The information is stored on a computer-readable medium. Since computer-readable mediums store information in the form of data, the information is stored on the computer-readable medium as data.

4. The Specification does not give the claim phrase "computer-readable medium" an explicit definition but rather discloses a range of conventional devices for storing data:

> [40] Fig. 1 is a simplified block diagram of a distributed system 10 that might incorporate an embodiment of the present invention. …
>
> [47] … As shown in Fig. 1, IP data processing system 100 includes server 101 (e.g., a Web server), a data storage repository such as database 106, … .
>
> [52] The computer systems depicted in Fig. 1 may be of the form depicted in Fig. 2. Fig. 2 is a simplified block diagram of a computer system 200 according to an embodiment of the present invention. As shown in Fig. 2, computer system 200 includes at least one processor 202 that communicates with a number of peripheral devices via a bus subsystem 204. These peripheral devices may include a storage subsystem 206, comprising a memory subsystem 208 and a file storage subsystem 210, … .
>
> [57] … File storage subsystem 210 provides persistent (non-volatile) storage for program and data files, and may include a hard disk, a floppy disk drive along with associated removable media, a Compact Disk Read Only Memory (CD-ROM) drive, an optical drive, removable media cartridges, and other like storage media. … .

5. Accordingly, the claim phrase "computer-readable medium" means, for example, a hard drive of a computer.

6. According to the storing step of claim 1, the data is stored in a "case data unit."

7. The Specification defines "case data unit" as follows:

> [62] A case data unit stores data and/or a collection of electronic documents (or references to the electronic documents) that are related to a particular case, e.g., a patent application in a particular country. …
>
> [63] The case data unit may be implemented as a data structure, a file, a database, or any other structure capable of storing data and/or documents. …

8. Accordingly, the claimed phrase "case data unit" means, for example, a database.

9. According to claim 1, the case data unit stores data "related to the first intellectual property case and one or more documents related to the first intellectual property case."

10. The Specification defines the type of information and the types of documents the case data unit can store:

> [48] … The information in database 106 may include draft and completed invention disclosures, draft and completed patent application documents, draft and completed prosecution filings (e.g., amendments), information about discussions pertaining to invention disclosures and patent applications, patent and patent application status information, prior art publications, office actions, assignment papers, other forms and papers filed in or generated by a patent office, etc. … .

> [64] The documents stored in or referred to by a case data unit may include a variety of documents of different document types. Specific examples of documents types include an invention disclosure, a filed patent application, patent drawings, … forms, image files, … .

11. Accordingly, images are a type of document, related to a first intellectual property case, the case data unit stores.

12. Thus, claim 1 describes storing information and at least one document, such as an image, in a "case data unit," or database, on a "computer-readable medium," such as a hard drive.[2]

The prior art

13. Kamarei is directed to a computer based method and system for managing dockets for legal cases.

14. Kamarei describes a database which contains information related to legal cases. (See col. 6, l. 49) ("Case Listing Database") and Fig. 1, element 20.

15. Kamarei further describes the database as a means for bringing about documents. (See col. 11, ll. 40-52):

---

[2] We construe claim 1 as requiring the case data unit to store information *and* at least one document. The Examiner suggested that the storing step could be construed to require the case data unit to store only data *related* to at least one document, rather than the document itself. (Answer 15). That construction is negated by dependent claim 24 (24. The method of claim 1, further comprising: scanning a paper to produce a scanned document in a computer readable format; wherein *storing one or more documents comprises storing the scanned document.*). Emphasis added.

> Automated Document Generation and Filing System
>
> In a preferred embodiment, the Host Server System further comprises of a document generation step wherein any one or combination of the following documents are created by the host server system using information contained in the Case Listing Database 20; legal documents, action prompt reports, action prompt due date reports, client system defined forms, and client system defined letters. In an embodiment the documents are prepared automatically as a result of a time criteria. The time criteria are optionally defined by the client system in the host server system and optionally include a set date.

16. Lee relates to a system and method for managing fees associated with the processing and handling of intellectual property transactions.

PRINCIPLES OF LAW

Anticipation

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a

person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18-19.

ANALYSIS

Rejection of claims 1, 2, 5-20 under 35 U.S.C. § 102(b) as being anticipated by Kamarei

The Appellant argued claims 1, 2, and 5-20 as a group (Br. 7-10). We select claim 1 as the representative claim for this group, and the remaining claims 2 and 5-20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007). Claim 1 is reproduced *supra*.

The Appellant's sole argument (Br. 7-10) is that Kamarei does not describe the claim 1 step of:

> storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.

Based on the broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art, the step in question is drawn to storing information and at least one document in a case data unit, such as a database, on a computer readable medium, such as a hard drive. (FF 12). Accordingly, the Appellant is arguing that Kamarei fails to describe storing information and a document in, for example, a database on a hard drive. (We recognize that the

information in the claim 1 method relates to intellectual property cases. But a distinction between information related to intellectual property cases and information related to another subject is a distinction grounded on nonfunctional descriptive material. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Accordingly, we agree with the Examiner (Answer 13-14) that the limitation in claim 1 that relates the information to be stored to intellectual property cases is not patentably consequential.

There are two aspects to this argument: whether Kamarei describes (a) a database on a computer readable medium and (b) using that combination to store information and a document.

The first aspect to the argument is not in dispute. Kamarei describes a database on a computer readable medium. Kamarei is replete with disclosures of databases; most notably, Kamarei's method comprises operating a "Case Listing Database." (FF 15). Since databases cannot operate apart from the computer readable medium that they are on, in operating a database Kamarei necessarily, and thus inherently, describes a computer readable medium for holding the database.

On the question of whether the Kamarei uses its database to store both information and documents, the Examiner directed the Appellant's attention to disclosures at col. 5, ll. 19-31; col. 6, l. 49 ("Case Listing Database"); col.

10, ll. 6-10; Fig. 6; col. 8, l. 45 – col. 9, l. 2; col. 9, l. 32 – col. 10, l. 9; col. 10, ll. 64-67; col. 11, ll. 40-67; and, col. 13, ll. 55-63. Answer 3-4. The Appellant contends that none of these disclosures describe a database used in the manner claimed. "Specifically, the final Office action identifies nothing in Kamerei [sic] that even remotely teaches the storage of such documents, let alone the storage of such documents in a case data unit that stores data related to the first intellectual property case and one or more documents related to that case, as recited by the independent claims." Br. 9.

We disagree with the Appellant. We have carefully reviewed Kamarei and the disclosures cited by the Examiner and find that Kamarei discloses using its database to store both information and documents. We reach this finding based on the disclosure in Kamarei at col. 11, ll. 40-52. (FF 15). That passage indicates that Kamarei's method comprises a document generation step where "any one or combination of the following documents are created using information contained in the Case Listing Database 20." "[T]he following documents" includes, for example, "legal documents." One of ordinary skill would understand Kamarei's database to operate conventionally and that would include bringing about documents from information contained in a database that is in the conventional forms of either data or documents. One having ordinary skill in the art would understand the disclosure of Kamarei to expressly disclose bringing about the particular documents disclosed by getting information in the form of a

document or data from a database. As such, Kamarei reads on the storing of documents and information in the claimed case data unit.

Accordingly, we are not persuaded by the Appellant's argument as to error in the rejection.

Rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over Kamarei

The Appellant argued against the rejection of claim 3 for the same reasons used to argue against the rejection of claim 1. (Br. 10). Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 3.

The legal standard for determining obviousness set forth in the brief appears to be an accurate reflection of the law on obviousness at the time the brief was filed. (Br. 10). However, *KSR*, which issued after the filing of the Brief, has since clarified the law on obviousness. The legal standard for determining obviousness is now more flexible. We direct *KSR* to the Appellant's attention for future reference.

Rejection of claims 21-26 under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee

The Appellant argued against the rejection of claims 21-26 for the same reasons used to argue against the rejection of claim 1. (Br. 10-11). Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claims 21-26.

CONCLUSIONS OF LAW

The Appellants have not shown that the Examiner erred in rejecting claims 1, 2, and 5-20 under 35 U.S.C. § 102(e) as being anticipated by Kamarei; claim 3 under 35 U.S.C. § 103(a) as unpatentable over Kamarei; and, claims 21-26 under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee.

DECISION

The decision of the Examiner to reject claims 1-3 and 5-26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a) (1)(iv) (2007).

AFFIRMED

JRG

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